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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,706	05/01/2002	Stefan Kastner	20496-364	1805
42532	7590	01/29/2008		
PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110			EXAMINER COZART, JERMIE E	
			ART UNIT	PAPER NUMBER
			3726	
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			01/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/019,706

Applicant(s)

KASTNER, STEFAN

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaul (2,800,709) in view of Hu (CN 1,105,615).

Gaul discloses producing an aluminum composite material (figs. 1-5), wherein at least one cladding layer (2) from a first aluminum material (col. 3, lines 47-51) is provided, the cladding layer (2) is placed on a side of an ingot (1) made from a second aluminum material (col. 3, lines 47-51), and the cladding layer (2) and the ingot (1) are rolled wherein the rolling comprises several roll passes thereby producing the aluminum composite material (col. 4, lines 68-75). Gaul discloses treating at least one surface of the second ingot by preheating and then scalping (col. 4, lines 32-47). *See also figures 1-5 for further clarification.*

Gaul, however, does not disclose sawing the cladding layer from a first ingot made from a first aluminum in a longitudinal direction, the sawing comprising band sawing.

Hu discloses sawing a metal ingot (4) in a longitudinal direction using a band saw (3), in to provide a machine that is low in cost, reduces the amount of material consumed during sawing of the ingot, free from contamination, has a wide variety of

Art Unit: 3726

application ranges and increased working efficiency. *See abstract and figure for further clarification.*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to saw the layer of Gaul from an ingot in a longitudinal direction using a band saw, in light of the teachings of Hu, in order to provide a layer that was longitudinally band sawed from ingot using a machine that is low in cost, small in material consumption, and has a wide variety of ranges and increased working efficiency.

Regarding claims 8, 11, and 16, Gaul/Hu discloses all of the claimed subject matter except for the cladding layer having a thickness of 2mm to 100mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cladding layer of Gaul/Hu with a thickness in the range of 2mm to 100mm, as the Examiner takes Official Notice that cladding layers in such a thickness range are conventional and are of sufficient thickness to provide the intended desirable cladding characteristics. Further, it has been held where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves on routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

3. Applicant's arguments filed 11/30/07 have been fully considered but they are not persuasive.

Applicant argues that Hu does not teach with respect to claims 6 and 14, "sawing at least one cladding layer from a first ingot made from a first aluminum material in a longitudinal direction".

In response, the Examiner maintains that Hu discloses sawing what can be considered at least cladding layer from a first ingot made from steel in a longitudinal direction as clearly shown in the figure. Although the ingot material is not aluminum the primary reference to Gaul discloses the cladding layer being aluminum, yet Gaul is silent with respect to the manner by which the cladding layer is formed. The teachings of Hu show that a layer can be cut from an ingot using a saw in a longitudinal direction wherein the layer appears to have dimension suitable for use as a cladding layer, and the mere fact that Hu longitudinally cuts the steel ingot using a saw is only an example, and does not preclude one of ordinary skill in the art from realizing that a less dense material such as aluminum can be longitudinally cut using the saw of Hu.

Applicant argues that Gaul or Hu alone or in combination fail to teach or suggest each and every element of independent claims 6 and 14.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Gaul discloses all of the claimed subject matter except for sawing the cladding layer of aluminum from a first ingot in a longitudinal direction. Hu discloses sawing a layer from an ingot in a longitudinal direction. The fact Hu discloses sawing

Art Unit: 3726

the layer provides the necessary teaching of how to produce a layer which appears to be suitable for use as a cladding layer.

Applicant argues that there is no motivation to combine Gaul and Hu.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gaul being the primary reference discloses all of the claimed subject matter as explained in detail above, however, Gaul fails to disclose the manner by which the cladding layer is produced. Hu discloses that a layer can be cut from an ingot in a longitudinal direction using a saw efficiently and accurately such as to reduce material consumption and provide layer that is free from contamination. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to saw the layer of Gaul from an ingot in a longitudinal direction using a band saw, in light of the teachings of Hu, in order to provide a layer that was accurately sawed from ingot and free from contamination using a machine that is low in cost, reduces the amount of material consumption, and has a wide variety of ranges thereby providing increased working efficiency.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3726

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JERMIE E. COZART
PRIMARY EXAMINER

January 23, 2008